

Application No. 10/606,330

### REMARKS

The reference to copending applications has been updated as suggested by the Examiner on page 2, paragraph 1, of the Official Action.

The rejection of Claims 1 to 6, 8 and 11 to 32 under 35 U.S.C. 103(a) as being unpatentable over Patel et al. 6,767,684 in view of Patel et al. 6,656,658 is respectfully traversed.

The Examiner has pointed to no teachings in the Patel et al. '684 patent wherein the aggregates are stabilized with a silicate salt dissolved in a base, reference Claim 1 of the present application as filed. Moreover, the Examiner has not indicated where in this reference the combination of components of Claim 1, including stabilizing the aggregates with a silica salt, are illustrated in the '684 patent, particularly without the benefit of the teachings of the present application. Accordingly, as this is the primary reference, it is believed that the combination rejection should be withdrawn.

With regard to the Examiner's comment concerning the silica coating magnetite or the aggregate particles, the Examiner is referred to page 13, beginning at line 15.

Moreover, Applicants would consider the submission of a 131 Declaration which should establish conception and reduction to practice of embodiments of the present application as encompassed by a number of the claims prior to the January 29, 2003 effective filing date of the 6,767,684 patent.

Concerning the Patel et al. '658 patent, the Examiner indicates that it teaches a toner process in which a latex emulsion can have an acicular latex in the second heating of the dispersion. While this may be accurate, the Examiner has pointed to no teachings in this reference or this reference in combination with the '684 patent with respect to the combination of components as recited, for example, in rejected Claim 1, and wherein the aggregates are stabilized with a silicate salt.

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The rejection of Claims 33 and 34 under 35 U.S.C. 103(a) as being unpatentable over Patel et al. '684 is respectfully traversed for the same or similar reasons as discussed herein with reference to the rejection of Claims 1 to 6, 8 and 11 to 32. More specifically, while the heating step in relation to the Tg of the resin is shown in column 20, lines 26 to 34, of the '684 patent, the Examiner has pointed to no teachings in the '684 patent wherein, for example, there is selected the stabilization of the aggregates with a silicate salt. In column 20, beginning at line 26, there is mentioned the changing of the pH and also that there may be added a pH increasing agent of, for example, sodium hydroxide, which increase in the pH assists in stabilizing the aggregate particles, see column 20, beginning at line 40; however, the Examiner has pointed to no teachings wherein a silicate salt dissolved in a base, reference Claim 1 of the present application, is disclosed or obvious from a review of the '684 patent.

Furthermore, the Examiner has referred to 35 U.S.C. 103(c), which indicates that subject matter developed by another person, which qualifies as prior art only one or more of subsections (e), (f) and (g) of section 102, should not preclude patentability under this section with the subject matter and the claimed invention were, at the time the invention was made, owned by the same person, or subject to an obligation of assignment to the same person. This situation exists with respect to the present application and the references being applied by the Examiner, namely the Patel et al. '684 patent and the Patel et al. '658 patent, both of which are owned by a common Assignee, Xerox Corporation, as a review of these files will readily reveal.

Concerning Claims 4, 5, 8, 22 and 23 as being rejected under 35 U.S.C. 112, second paragraph, it is believed that these rejections have been alleviated in view of the clarifications accomplished which are believed to be in accordance with the Examiner's suggestion on page 3, paragraph 6, of the Official Action.

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Applicants note that Claims 7, 9 and 10 are objected to as being dependent on a rejected base claim, but will be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. In view of the comments presented herein, Applicants have not accomplished the amendments to these claims at this time.

Accordingly, it is respectfully urged that the Examiner reconsider his positions and allow the claims in their present form.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



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